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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,863	10/15/2001	Jed Arkin	62962CIP(52398)	4296
21874	7590	02/03/2006	EXAMINER	
EDWARDS & ANGELL, LLP P.O. BOX 55874 BOSTON, MA 02205			WINDER, PATRICE L	
			ART UNIT	PAPER NUMBER
			2145	
DATE MAILED: 02/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,863

Applicant(s)

ARKIN ET AL.

Examiner

Patrice Winder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-166 is/are pending in the application.
- 4a) Of the above claim(s) 1-58, 102-123 and 164-166 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-101, 124-163 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1-29-02</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election with traverse of invention IV in the reply filed on September 29, 2005 is acknowledged. The traversal is on the ground(s) that there is overlap among the claims. This is not found persuasive because the "overlap" that applicant argues does not take into consideration that each invention is an established art. In comparison of Inventions I-III, the "overlaps" are essentially nominal recitations without the same distinguishing features as the elected invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-58, 102-123, 164-166 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 29, 2005.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 59 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A "modified item" is a data structure which is non-statutory subject matter which is not "tangibly" embodied.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 62 recites the limitation "the beginning portion" in lines 25-26. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 62 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The "whereby" clause renders functional language without limitation

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 59-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiser et al., USPN 6,385,596 B1 (hereafter referred to as Wiser).
10. Regarding claim 59, Wiser taught a modified item (column 6, lines 47-52), comprising;

at least one modified item characteristic (column 7, lines 17-46);

modified item content (column 7, lines 4-16);

wherein said modified item is produced according to at least one characteristic of an item, item content of said item and at least one supplementary material (column 8, lines 11-17).

11. Regarding dependent claim 60, Wiser taught said at least one supplementary material is a notice that said modified item is a modified copy of an intellectual property item (column 9, lines 40-52).

12. Regarding dependent claim 61, Wiser taught said at least one supplementary material is in a form selected from the list consisting of: text; graphics; animation; and voice (column 8, lines 11-17).

13. Regarding dependent claim 62, Wiser taught the beginning portion of said modified item before said at least one supplementary material is usable, whereby a network node continues to download said modified item, after examining said beginning portion (column 15, lines 33-67).

14. Regarding dependent claim 63, Wiser taught said at least one supplementary material is a purchase offer for a network node which downloads said modified item, to purchase a usable copy of said modified item (column 7, lines 63-64; column 16, lines 31-46).

15. Regarding dependent claim 64, Wiser taught said at least one supplementary material includes at least one link to at least one network site (column 16, lines 31-46), and

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wherein said at least one network site includes a purchase offer for a network node which downloads said modified item, to purchase a useable copy of said modified item (column 7, lines 63-64; column 16, lines 31-46).

16. Regarding dependent claim 65, said at least one supplementary material includes at least one network site (column 16, lines 31-46), and

wherein said at least one network site includes a membership offer for a network node which downloads said modified item, to operate similar to a repository network node (column 13, lines 4-15),

wherein said repository network node uploads a modified copy of an intellectual property protected item to another one of said network node, when said repository network node receives an upload request from said another network node, to upload said intellectual property protected item (column 20, line 65 – column 21, line 28).

17. Claims 66-71, 73-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Shuster, USPN 6,826,546 B1 (hereafter referred to Shuster) and Applicant's admitted prior art (AAPA) in paragraphs 24-26.

18. Regarding claim 66, Shuster taught method for uploading an item to a network node, over a network (Gnutella, column 1, lines 52-62; column 3, lines 49-57), the method comprising the steps of:

determining the type of said item (digital file type, column 1, lines 52-62); and
forwarding an item query to a plurality of selected repository network nodes which belong to a selected group of repository network nodes (column 1, lines 52-62), when said item is intellectual property (IP) protected and forwarding said item query to a

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plurality of other repository network nodes which do not belong to said selected group, when said item is not IP protected (column 3, lines 60-65).

19. Regarding dependent claim 67, Shuster taught further comprising a preliminary step of receiving said item query by each of said selected repository network nodes, from said network node (Gnutella AAPA).

20. Regarding dependent claim 68, Shuster taught further comprising a preliminary step of receiving a logged-on list by said network node, from a network server, over said network (Gnutella AAPA).

21. Regarding dependent claim 69, Shuster taught further comprising a preliminary step of sending a logged-on query by said network node, to said network server (Gnutella AAPA).

22. Regarding dependent claim 70, Shuster taught further comprising a step of sending item query response to said network node, by each of said selected repository network nodes, which belongs to said selected group (Gnutella AAPA).

23. Regarding dependent claim 71, Shuster taught further comprising a step of receiving an upload request from said network node, by a selected repository network node which belongs to said selected group, to upload said item (column 3, lines 60-65).

24. Regarding dependent claim 73, Shuster taught further comprising a step of sending an item query response to said network node, by each of said other repository network nodes which does not belong to said selected group (Gnutella AAPA).

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25. Regarding dependent claim 74, Shuster taught further comprising a step of receiving an upload request from said network node, by a selected one of said other repository network node, to upload said item (Gnutella AAPA).

26. Regarding dependent claim 75, Shuster taught further comprising a step of uploading said item to said network node, by said selected other repository network node (Gnutella AAPA).

27. Regarding dependent claim 76, Shuster taught said step of determining further comprises a procedure of comparing at least one characteristic of said item, with at least one entry in an item characteristics list (column 4, lines 43-52), wherein said item characteristics list is located in a shared-items directory, said shared-items directory further includes said items, said shared-items directory is located in each of said selected repository network nodes (Gnutella, AAPA), wherein said item is IP protected when said at least one characteristic matches said at least one entry (column 1, lines 57-62); and wherein said item is not protected when said at least one characteristic does not match said at least one entry (column 1, lines 57-62).

28. Regarding dependent claim 88, Shuster taught a step of sending information to a network control node, respective of said step of receiving (Gnutella AAPA).

29. Claims 124-134, 136-158, 160-163 are rejected under 35 U.S.C. 102(e) as being anticipated by Hale et al., USPN 6,732,180 B1 (hereafter referred to as Hale).

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30. Regarding claim 124, Hale taught a method for uploading a modified copy of an infringing item, to a network node, over a network (abstract), the method comprising the step of:

uploading said modified copy from a repository network node, when said repository network node is not occupied, and sending an upload request by said repository network node to a network control node, when said repository network node is occupied (column 8, lines 49-65).

31. Regarding dependent claim 125, Hale taught a preliminary step of receiving said upload request by said repository network node, from said network node, to upload said infringing item (column 9, lines 24-31).

32. Regarding dependent claim 126, Hale taught a step of locating an unoccupied repository network node, after said step of sending, wherein said network control node performs said step of locating (column 8, lines 45-48; column 9, lines 1-6).

33. Regarding dependent claim 127, Hale taught a step of forwarding said upload request to said unoccupied repository network node (column 8, lines 45-48; column 9, lines 1-6).

34. Regarding dependent claim 128, Hale taught a step of uploading said modified copy to said network node, by said unoccupied repository network node (column 8, lines 45-48; column 9, lines 1-6).

35. Regarding dependent claim 129, Hale taught network node proliferates said modified copy in said network, when said network node is not attended by the person who operates said network node (column 9, lines 7-22).

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36. Regarding dependent claim 130, Hale taught a preliminary lo step of retrieving said modified copy from a shared-items directory located in said repository network node (column 9, lines 7-22).

37. Regarding dependent claim 131, Hale taught a step of updating said shared-items directory, by a control application (column 8, lines 49-55).

38. Regarding dependent claim 132, Hale taught a preliminary step of retrieving said modified copy from a shared-items directory located in said unoccupied repository network node (column 9, lines 7-22).

39. Regarding dependent claim 133, Hale taught a updating said shared-items directory, by a control application (column 9, lines 7-22).

40. Regarding dependent claim 134, Hale taught a step of controlling the operation of said repository network node, and said unoccupied repository network node, by a control application (column 9, lines 7-22).

Claim Rejections - 35 USC § 103

41. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

42. Claims 72, 77-87, 89-101, 135 and 159 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuster in view of Hale.

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43. Regarding dependent claim 72, Shuster does not specifically teach uploading a modified copy of said item. However, Hale taught a step of uploading a modified copy of said item to said network node, by said selected repository network node (column 8, lines 40-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Hale's uploading a modified copy in Shuster's system for licensing a copy of a copyright protected work would have improved system security. The motivation would have been to further inhibit the unlawful distribution of proprietary media.

44. Regarding dependent claim 77, Shuster does not specifically teach controlling the operation of selected repository nodes. However, Hale taught further comprising a step of controlling the operation of each of said selected repository network nodes, by control application (column 5, line 57- column 6, lines 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Hale's controlling selected repository nodes in Shuster's system for licensing a copy of a copyright protected work would have improved system security. The motivation would have been to further inhibit distribution of proprietary media.

45. Regarding dependent claim 78, Hale taught further comprising a step of updating said shared-items directory, by said control application (column 8, line 56 - column 9, line 6).

46. Regarding dependent claim 79, Hale taught further comprising a step of modifying said shared-items directory, by said control application (column 8, line 56 - column 9, line 6)

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47. Regarding dependent claim 80 and 135, Shuster taught further comprising a step of downloading an update of said control application from a network control node (column 4, lines 53-60).

48. Regarding dependent claim 81, Shuster does not specifically teach producing a translated name for an item. However, Hale taught further comprising a step of producing at least one translated name for said item (column 6, lines 35-41), wherein said at least one translated name is produced by a translator coupled to said network, according to at least one item characteristic of said item, for identifying said at least one translated name by each of said selected repository network nodes associated with another translator similar to said translator (column 6, lines 23-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Hale's producing a translated name in Shuster's system for licensing a copy of a copyright protected work would have improved system robustness. The motivation would have been to ensure that new media is available to share frequently.

49. Regarding dependent claim 82, Shuster does not specifically teach periodically changing at least one attribute. However, Hale taught further comprising a step of periodically changing at least one attribute respective of each of said selected repository network nodes (column 7, lines 47-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Hale's periodically changing attributes in Shuster's system for licensing a copy of a copyright protected

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work would have improved system robustness. The motivation would have been to ensure that new media is available to share frequently.

50. Regarding dependent claim 83, Hale taught said at least one attribute is selected from the list consisting of: network interface card identification; logical user name; network service provider; and network protocol address (column 7, lines 47-55).

51. Regarding dependent claim 84, Shuster does not specifically teach initiating a log-off and a log-on script in each of said selected repository network nodes, by a control application. However, Hale taught a step of initiating a log-off and a log-on script in each of said selected repository network nodes, by a control application (column 9, lines 1-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Hale's initiating log-in and log-off by a control application in Shuster's system for licensing a copy of a copyright protected work would have improved system security. The motivation would have been to further inhibit distribution of proprietary media.

52. Regarding dependent claim 85, Hale taught wherein said step of uploading is performed at a high quality of service, during the uploading of the beginning portion of a modified copy of said item, and at a low quality of service during the uploading the remainder of said modified copy (column 8, lines 10-28).

53. Regarding dependent claim 86, Hale taught the quality of service is alternated between a high value and a low value, while performing said step of uploading (column 8, lines 10-28).

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54. Regarding dependent claim 87, Shuster does not specifically teach network commands. However, Hale taught a step of automatically sending a network notification command to at least one network server, over said network, by each of said selected repository network nodes, at predetermined time intervals (column 9, lines 17-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Hale's network commands in Shuster's system for licensing copyright protected works would have improved system robustness. The motivation would have been to have better controls to issue commands to share clients.

55. Regarding dependent claim 89, Hale taught further comprising a step of sending information to a network control node, respective of said step of uploading (column 10, lines 5-16).

56. Regarding dependent claim 90, Hale taught further comprising a step of sending information to a network control node, respective of said modified copy (column 10, lines 5-16).

57. Regarding dependent claim 91, Hale taught said control application enables each of said selected repository network nodes, to send periodically an activity report to a network control node (column 10, lines 20-41).

58. Regarding dependent claim 92, Hale taught said activity report includes a plurality of entries selected from the list consisting of:

number of times which at least one network connection between each of said selected repository network nodes and said network node, is disconnected in a given time period;

bandwidth of at least one other network connection between each of said selected repository network nodes and said network control node;

network protocol address of said network node, which sends said item query to each of said selected repository network nodes, in a given time period; and

most popular ones of at least one modified copy of said items which each of said selected repository network nodes uploads to said network node, in a given time period (column 6, lines 19-22; column 10, lines 20-41).

59. Regarding dependent claim 93, Hale taught further comprising a step of monitoring the activity of a repository network node, by said network control node, by comparing said activity report of said repository network node, with said activity node report of another repository network node, wherein said repository network node and said another repository network node belong to said selected group (column 10, lines 20-34).

60. Regarding dependent claim 94, Hale taught further comprising a step of adjusting the load on a selected repository network node, by said network control node, according to the outcome of said comparison step, wherein said selected repository network nodes belongs to said selected group (column 4, lines 1-25).

61. Regarding dependent claim 95, Hale taught further comprising step of rating the activity of a selected repository network node, by said network control node, by comparing said activity report of said selected repository network node, with said activity report of another selected repository network node (column 10, lines 20-41),

wherein said repository network node and said another repository network node, when the resources thereof are restricted, wherein said selected repository network node belongs to said selected group (column 7, lines 52-60).

62. Regarding dependent claim 96, Shuster taught further comprising a step of determining by said network control node, whether to offer a reward to said selected repository network node, according to the outcome of said comparison step (column 2, lines 45-53).

63. Regarding dependent claim 97, Shuster does not specifically teach degenerating routing capacity. However, Hale taught a step of degenerating the routing capacity of a selected repository network node, when the resources are restricted, wherein said selected repository node belongs to said selected group (column 8, lines 56-65).

64. Regarding dependent claim 98, Hale taught the type of said resources is selected from the list consisting of: bandwidth; memory; and processing time (column 8, lines 56-65).

65. Regarding dependent claim 99 and 159, Shuster taught further comprising a preliminary step of signing said item with a digital signature, by a network control node (column 5, lines 40-49). Shuster does not specifically teach a modified copy of said item. However, Hale taught a network control node identifies a modified copy of said item, wherein said modified copy resides in a selected one of said network nodes (column 9, lines 11-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Hale's modified item in Shuster's

system for licensing copyright protected works would have improved system security.

The motivation would have been to inhibit downloading of proprietary copyrighted items.

66. Regarding dependent claim 100, Hale taught said step of uploading further comprises a procedure of directing a different one of said selected repository network nodes to uploading the remaining portion of said modified copy to said network node, wherein said selected repository network node ceases to upload said modified copy to said network node, during said step of uploading, wherein said step of directing is performed by a network control node (column 8, lines 49-65).

67. Regarding dependent claim 101, Hale taught said step of uploading further comprises a procedure of continuing the uploading of the remaining portion of said modified copy of said network node, by a network control node, when said selected repository network node ceases to upload said modified copy to said network node, during said step uploading (column 8, lines 49-65).

68. The language of claims 135-163 is substantially the same as previously rejected claims 72-101, above, Therefore, claims 135-163 are rejection on the same rationale as previously rejected claims 72-101, above.

Conclusion

69. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

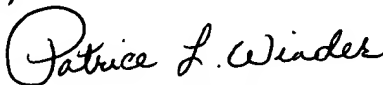
70. Fritsch, USPN 6,247,130 B1: taught distribution of musical products by a web site vendor over the Internet.

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71. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrice Winder
Primary Examiner
Art Unit 2145

January 23, 2006